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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,965	12/07/2001	Paul J. Datta	KCC-16,986	5676
35844	7590	03/09/2005		
PAULEY PETERSEN & ERICKSON 2800 WEST HIGGINS ROAD HOFFMAN ESTATES, IL 60195			EXAMINER REICHLE, KARIN M	
			ART UNIT 3761	PAPER NUMBER

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/010,965	DATTA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Karin M. Reichle	3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 13-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 40-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. The FINAL issued 3-19-04 is withdrawn. A non-final action on the merits follows.

#### ***Election/Restriction***

2. Claims 13-39 are still withdrawn from consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected groups, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 10.

#### ***Drawings***

3. The drawings were received on 9-23-03. These drawings, Figures 1-5, are approved by the Examiner. However, see the PTO-948 with the 3-19-04 action.

4. It should be noted that the drawings filed 9-29-03 did not comply with 37 CFR 1.121 effective 7-30-03 because the sheets of drawings were not labeled "REPLACEMENT SHEET" nor were the changes made explained in either the drawing amendments or remarks section, i.e. only a general statement that some changes were made was provided. Any further submittal of Figures must be in compliance with 37 CFR 1.121 effective 7-30-03.

#### ***Claim Language Interpretation***

5. The first and second ear panels are not required to be formed of only the first and second materials, respectively, so the first and second ear panels are not required to have different basis weights only a respective first and second material thereof is. The first and

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second materials are not required to be a single layer or only one kind of material (Note claim 10). The terminology “passive bond” is defined as set forth on page 10, lines 1-3 and 4-5, i.e. a bond which has a relatively low peel strength such that the bond can be easily broken by hand if desired to assist in inspecting or removing an absorbent article from the wearer and without causing trauma to the wearer or spillage of waste materials from the absorbent article. It is noted that the language “relatively low” and “easily” are considered relative. It is also noted that the claim terminology “manually” is considered redundant, see definition of “passive bond”. It is noted that the terminology “passive bond” does not require tearing or damage or the lack thereof, i.e. as “passive bond” is defined the capability of the bond to be broken with or without tearing or damage is set forth as a preference not a requirement absent specific claim language requiring such, i.e. see the last sections of claims 40-43. The portion of the definition of “passive bond”, i.e. “to assist...article.” supra recites function, capability or property of the “passive bond”. It is also noted that the claim language does not require direct connection of the ear panels together by the “passive bond”. The claims do not require a side seam or seal which include the front ear panel or/and the first material passively bonded to a back ear panel or/and the second material or that tearing the bond totally disconnects the front ear panel from the back ear panel. Additionally in claims 40 and 42-43, the terminology “disconnecting” in the wherein clause is considered to refer back to the terminology “connecting” in the subsection prior to the wherein clause, i.e. the disconnection refers to that of the at least one passive bond.

***Claim Rejections - 35 USC § 102/103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 8 and 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 USC 103(a) as being obvious over Johnson et al '589

With regard to all the claims, see Figures 3-3A, then see Figures 5-7, then see Figure 4. Also see Figures 1-2 and 8, col. 3, lines 56-60, col. 6, line 16-col. 8, line 44 and col. 9, lines 6-42 (Note col. 7, line 53 and col. 9, line 13, "joining means 205" is incorrect and should be --joining means 300-- to be consistent with the remainder of the reference, i.e. the front waist region is 56, the back waist region is 54, the crotch region is 57, the first ear panel is 202 with or without 205 or 200 with or without 205, the second ear panel is 200 without or with 205, respectively, or 202 without or with 205, respectively, and the bond is "joining means" 300, see again, e.g., Figures 4 and 5 and col. 7, lines 53-57 (Note a tearable 205 could also be used as 205 in the embodiment of Figure 4 or, alternatively, the ear panels in Figure 5 could be folded as shown in Figure 4, see col. 7, lines 57-59). The material of the ear panels are "different" materials, see again, for example, the Figures, the paragraph bridging cols. 7-8, and col. 7, lines 2-37, i.e. again one of the panels includes 205 and one does not.

With regard to claims 1 and 8, the claim requires the second material having a basis weight greater than the basis weight of the first material. However since one of the ear panels includes element 205 and one does not (note Applicant's argument in the Appeal Brief that elements 200 and 202 each without 205 are the same), the basis weight of the one ear panel

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including element 205 is or obviously is greater than the other ear panel which does not include 205.

With regard to the functions, properties and capabilities of the “passive bond” as defined in the independent claims, see claim language interpretation section *supra*, i.e. “The portion of the definition of “passive bond”, i.e. “to assist...article.” *supra* recites function, capability or property of the “passive bond”.”, the Johnson device includes or obviously includes all the structure of the claims. Therefore there is sufficient factual basis for one to conclude that the functions, properties and capabilities of the claimed structure are also inherent in, see MPEP 2112.01, or necessarily and inevitably present in the same structure of Johnson. Especially note Figure 8 which shows tearing of the bond of Johnson increases the size of the waist opening, i.e. would or necessarily and inevitably assist in inspecting or/and removal.

With regard to the last subsections of claims 40-43, see portions of Johnson et al cited *supra*, especially the folding in Figures 3-4, col. 7, lines 57-59, the folding and element 205 in Figures 5-7, col. 9, lines 17--24, i.e. the ear panel not including element 205 remains in the same form, i.e. is not damaged or the tensile strength is not negatively affected. The elements 200, 202 have a tensile strength such that 205 will tear before 200, 202 do, see again col. 9, lines 28-30. Also note col. 9, lines 20-24. Therefore, since that one of the ear panels is not damaged or its tensile strength is not negatively affected, such ear panel is affected or damaged less than the other ear panel.

With regard to the last subsection of claim 40, see col. 7, lines 6-12 and col. 6, lines 23-28 and Figures 5-7, i.e. the front one of 200, 202 can be unitary with 205, i.e. front panel/bond torn but rear panel is not.

***Claim Rejections - 35 USC § 103***

8. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson '589.

Claims 2-6 require a specific basis weight of at least one of the materials and claim 7 requires a specific tensile strength of the second material. While the criticality of different basis weights of first and second materials of front and rear ears passively bonded to each other directly to form side seams is disclosed, the criticality of specific basis weights and tensile strengths has not been disclosed. As discussed supra, the general conditions of the claims are taught by the prior art, i.e. materials of different basis weights forming panels bonded together. Therefore, since the general conditions are disclosed by the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation. See *In re Allen*, 105 USPQ 233.

9. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being obvious over Johnson et al in view of McNichols, '805, and thus also Morman '992.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the

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application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP 706.02(l)(1) and 706.02(l)(2).

In claims 9-10 Applicant claims specific first and second materials of the panels. It is noted that the claims do not limit the panels or materials thereof only to the specified materials, or in other words the ears and materials can include additional elements. In claims 11-12 Applicant claims specific peel strengths. The Johnson et al reference does not explicitly teach such. It is noted however that Johnson et al do teach readily tearable side bonds and that the ear panels can be any material known in the art that is suitable for use in disposable articles which may be joined together by a seam. However, see McNichols at col. 16, lines 6-24 and col. 13, lines 15-30, and thereby Morman at Figure 5, Example 3, col. 6, lines 47-54, col. 8, lines 30-40, i.e. a material known in the art suitable for use in disposable articles includes point bonded nonwoven materials as claimed in claim 9 and laminates as claimed in claim 10 and readily tearable bonds of such material have peel strengths as set forth in claims 11 and 12. To employ the materials and peel strengths as taught by McNichols on the Johnson et al device would be obvious to one of ordinary skill in the art in view of the recognition that such materials are known materials in the art suitable for use in disposable articles and that such peel strengths between such materials provide readily tearable bonds and the desire by Johnson to employ any



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material known in the art that is suitable for use in disposable articles and to provide bonds with such material that are readily tearable. Applicant's attention is also invited to the discussion of prior art infra.

### ***Response to Arguments***

10. Applicant's remarks with regard to the prior art rejections have been considered but are deemed not persuasive because such are narrower than the teachings of Johnson and/or the claim language, Applicant's attention is again invited to the Claim Language Interpretation section supra and the discussion of Johnson in the prior art rejection supra.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Schwartz can be reached on (571) 272-4390. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Karin M. Reichle  
Primary Examiner  
Art Unit 3761

KMR  
March 5, 2005